



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,183	09/15/2000	Christine Dupuis	05725.0753-00000	4212

22852 7590 02/12/2003

FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20006

EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
----------	--------------

1617

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/663,183

Applicant(s)

DEPUIS, CHRISTINE

Examiner

Lauren Q Wells

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-102 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-102 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 20.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-102 are pending.

Request for Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/22/02 has been entered.

Double Patenting

The Double Patenting Rejection in the previous Office Action is withdrawn, as the claims of 09/662796 are drawn to a device and comprise a composition distinct from that of the instant invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-10, 12-16, 19-20, 26, 57-59, 61-65, 68-69 and 75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(ii) The term "derivatives" in claims 12, 16, 57, 61, and 65, is vague and indefinite. The term "derivatives", in reference to these claims, is neither defined in the specification nor would it be apparent to one of ordinary skill in the art, as this term encompasses an incredible number

of chemical possibilities, and thus compounds. As a result, the metes and bounds of these claims are unascertainable.

(ii) Claims 19, 26, 68, and 75 are vague and indefinite, as they are confusing. Is the silicone derivative (b) chosen from compounds of formula I or from derivatives of formula I. Does the rest of the claim, which defines formula I, define the derivatives of formula I or does it define the formula, wherein (b) can be chosen from derivatives of the defined formula?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-102 are rejected under 35 U.S.C. 103(a) as being unpatentable.
over Blackenburg et al. (WO 99/04750) in view of Myers et al. (WO 94/12148).

Blackenburg et al. teach the use of polymers containing polysiloxanes for hair cosmetic formulations. A water-dispersible polymer comprising ethylenically unsaturated monomers and polyalkylene oxide containing silicone derivatives is taught. The silicone derivative of formula (I) of the instant invention is taught, as is its R^1 , R^2 , R^3 , and R^5 constituents. Dimethicone copolyols and silicone surfactants are disclosed as preferred compounds of formula I. The ethylenically unsaturated monomer of formula (I_a) of the instant invention is also disclosed, as is its X, R^7 , and R^6 constituents, as are ethylenically unsaturated monomers further comprising silicone atoms, fluorine atoms, and thio groups, which meets claims 18 and 67. The

silicone/acrylate copolymers are soluble in a proportion of greater than 0.1 g/l, and preferably more than 0.2 g/l in a water/ethanol mixture, which meets claims 30, 31, and 79-80. Cosmetic additives disclosed include fragrances, preserving agents, vitamins, proteins, and others, which meets claim 48 and 97. A process of making and using the cosmetic product is disclosed. The reference lacks nonionic polymers comprising vinyl lactam units and preferred cosmetic mediums. See entire disclosure.

Myers et al. teach aerosol hair spray formulations. Formulations comprising vinyl lactam units of the formula of instant claim 34 are taught, as are vinyl lactam units with a phenyl group chosen from the copolymer of instant claim 35, which meets claims 35-36 and 83-85. N-vinyl-2-pyrrolidone and N-vinylpyrrolidone/vinyl acetate are taught as preferred polymers comprising vinyl lactam units, which meets claims 37 and 86. The non-ionic vinyl lactam polymers have a molecular weight of between 1000 and 100,000, which meets claims 38-40 and 87-89. Water/alcohol mixtures are taught as cosmetic mediums for the formulations, which meets claims 2 and 51. Ethanol is a preferred alcohol, which meets claims 43-47 and 92-96. See Page 1, lines 15-27; page 3, line 23-page 4, line 41; page 7, line 9-page 8, line 31; page 9, lines 15-23; page 10, line 25-page 16, line 36.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have added the nonionic polymer comprising at least one vinyl lactam unit, as taught by Myers, to the composition of Blackenburg because a) Blackenburg and Myers both teach hair care fixative compositions in the form of sprays; b) Myers teaches the nonionic vinyl lactam polymers as imparting consistency, firm texture, and maintenance of a desired arrangement to the hair; c) Blackenburg teaches that vinyl lactam homo and copolymers are known in the art as

Art Unit: 1617

synthetic polymers that have been used for almost 50 years to strengthen hairdos; d) Blackenburg teaches that other cosmetic agents can be added to his composition; thus, one of skill in the art would be motivated to add the nonionic polymer of Myers to the composition of Blackenburg because of the expectation of achieving synergistic fixative properties and of producing a hair spray that imparts consistency, firm texture, and maintenance of a desired arrangement to the hair.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

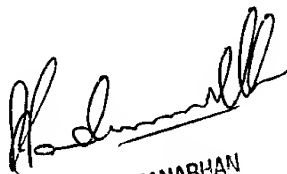
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
January 22, 2003


SREENI PADMANABHAN
PRIMARY EXAMINER

1/23/03